



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/716,531 09/19/96 MAHE

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EXAMINER

HUFF, S

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

03/24/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

08/716,531

Applicant(s)

Mahe et al

Examiner

Sheela J. Huff

Group Art Unit

1642



## THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Jan 15, 1998 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 13, 1998 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

☒ Applicant's response has overcome the following rejection(s):

The rejections under 35 USC 112 first paragraph and under 35 USC 112, second paragraph.

☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attached

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: noneClaims objected to: noneClaims rejected: 1-11 and 16-19

☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Other

SHEELA J. HUFF  
PRIMARY EXAMINER  
ART UNIT 1642

Art Unit: 1642

### **Advisory Action**

Applicant argues that the Hiltz et al reference teaches that only L-pro is active. This reference shows that lys-D-pro-val-NH<sub>2</sub> is inactive. First of all, applicant is NOT claiming the NH<sub>2</sub> form of the peptide. Secondly, the reference is a 1991 reference and the Oluyomi et al reference, which is a 1994 reference, clearly shows that lys-D-pro-valNH<sub>2</sub> is effective in the late phase (see page 137 (col. 1, lines 6-8)). Applicant is also directed to the last sentence on page 137 which states that "We conclude that useful analgesics may be developed from peptides containing the sequence Lys-D-Pro-X"(emphasis added). Thus, the 1994 reference does show and believe that peptides containing D-pro are anti-inflammatory.

Applicant again argues that pain is not inflammation. These arguments have been addressed in the previous response.

The Group handling your application has changed. Please direct all future communications to Group 1600, Art Unit 1642.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703)305-7866. The Examiner can be reached on Monday-Thursday from 6:30am to 3:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, then applicant can contact the Examiner's supervisor, Lila Feisee, at 703-308-2731.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lila.feisee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet usage Policy published

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in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-0196.

Sheela J. Huff  
March 23, 1998

  
Sheela J. Huff  
Primary Examiner